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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,279	08/15/2001	Keisei Yamamuro	742406-10	8203
22204	7590	08/24/2004	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			RAY, GOPAL C	
			ART UNIT	PAPER NUMBER
			2111	

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/929,279

Applicant(s)

YAMAMURO ET AL.

Examiner

Gopal C. Ray

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-19 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-19 and 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 17-19 and 21-31 are presented for examination.
2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. Furthermore, all claims should be revised carefully to eliminate all grammatical errors and antecedent basis problems.
3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 17-19 and 21-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 5,978,836 issued to Ouchi in view of US Patent 6,134,582 issued to Kennedy.

As per claim 17, the reference of Ouchi teaches "a body region describing content of the electronic mail" in Fig. 24, "E-MAIL"; "an auxiliary region describing data necessary for transmitting the electronic mail" in Fig. 24, element "LOCATION TABLE".

The reference of Ouchi fails to expressly teach the limitation "wherein operational control data for controlling an operation mode of the receiving device is included in the auxiliary region". However, this is a very broad limitation starting with a "wherein" clause. The claim does not recite sufficient structure or step to support the function. Moreover, the above feature was well known to one of ordinary skill in the art

at the time the invention was made as evidenced by Kennedy. The reference of Kennedy teaches the feature in col. 2, lines 42-56. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ouchi to implement the above feature of Kennedy to obtain the claimed invention because the reference of Ouchi shows an electronic mail which has a "control field" in col. 17, lines 13-28 and above feature of Kennedy would allow the system of Ouchi for managing messages communicated within a client server architecture. The reference of Kennedy teaches the feature in col. 2, lines 38-41.

As per claim 18, the reference of Ouchi teaches "a computer readable storage medium for storing the electronic mail data" in Fig. 3, element 32.

As per claim 19, the reference of Ouchi teaches "wherein the operation control data is data for controlling a user interface of the receiving device" in col. 7, lines 8-17.

As per claims 21, 22, 25 and 29, the claims are rejected for similar reasons as discussed in the rejection of claim 1 with the exception of "a user interface". However, the reference of Ouchi teaches the feature in col. 7, lines 8-17.

As per claims 24, 27 and 30, the claims are rejected for the same reasons as discussed in the rejection of claim 18.

As per claim 28, the reference of Ouchi teaches the added limitation in col. 8, lines 3-37.

As per claims 23, 26 and 31, the claims recite methods. However, the limitations are parallel to apparatus claim 21. In teaching the construction and use of the device, US Patent 5,978,836 issued to Ouchi teaches corresponding methods.

5. Applicant's arguments filed on 7/15/2004 have been fully considered but are moot in view of the new ground(s) of rejection.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gopal C. Ray whose telephone number is (703) 305-9647. The examiner can normally be reached on Monday - Friday from 8:00 AM - 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The new fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [mark.rinehart@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2100 receptionist whose telephone number is (703) 305-3900.

Gopal C. Ray
GOPAL C. RAY
PRIMARY EXAMINER
GROUP 2300